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10/088,715	03/19/2002	Alex Roche	60004065-4	7580

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EXAMINER	
ALLEN, WILLIAM J	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/088,715
Filing Date: March 19, 2002
Appellant(s): ROCHE, ALEX

Alex Roche
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/13/2008 appealing from the Office action mailed 3/19/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 8/12/2008 has been entered.

For the above reasons, it is believed that the rejections should be sustained.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims appears on page 9 of the Appendix to the appellant's brief. The minor errors are as follows:

Applicant has failed to list claims 2-62 and 74-77 as canceled. Per Applicant's Amendment made after final on 8/12/2008, claims 2-62 and 74-77 are cancelled.

(8) Evidence Relied Upon

6133985	Garfinkle et al	10-2000
US 6493677 B1	von Rosen et al	12-2002
US 20030140315 A1	Blumberg et al	12-2003
US 6016504	Arnold et al	01-2000
PTO form 892 reference V ("MediaFlex")		04-1999
PTO form 892 reference U ("Kinko's Prints it Big")		01-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 63-64, 67-68, and 72-73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US 6133985) in view of von Rosen (US 6493677) in further view of PTO form 892 reference V (herein referred to as MediaFlex).

2. Claims 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of MediaFlex, as applied to above, and further in view of Blumberg (US 20030140315).

3. Claims 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of MediaFlex, as applied to above, and further in view of Arnold et al. (US 6016504, herein referred to as Arnold).

4. Claims 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of MediaFlex in view of Arnold, as applied to claim 69, and further in view of PTO 892 reference U.

(10) Response to Argument

With regards to claims 1, 63, 64, 67, 68, and 73, Applicant asserts that the obviousness rejection made over Garfinkle in view of von Rosen in view of PTO 892 V is defective. The Examiner disagrees for at least the following:

Garfinkle teaches a method and system for processing digital images to facilitate ordering of prints and print products. More specifically, Garfinkle teaches the claim elements

displaying a plurality of image items for online viewing by said customer at a content retailer web site operated by or for a content retailer;

transacting an order of a first type between said customer and said content retailer for supply of said at least one print product based on said customer ordering said at least one print product after viewing at least one of said image items at said content retailer; and

transacting an order of a second type between said content retailer and said print merchant for fulfillment of said first type order by said print merchant [Note citations in the Final Rejection].

Additionally, Garfinkle teaching where the fulfillment center "fulfills, charges, and delivers" an order (see at least: col. 3 lines 21-23), and further where the order may "be delivered by standard mail" (see at least: col. 9 lines 34-35). Garfinkle, however, lacks the recited feature of *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order.*

Garfinkle also fails to explicitly teach *offering a direct service to business customers for generating print products from their own content*, the fulfillment of *business customer* orders by the print merchant, and where *image items being made available to said content retailer for public merchandising* are from *at least one third party content provider.*

With this it mind it is pertinent to note that (1) the elements are all known but not combined as claimed, (2) the technical ability exists to combine the elements as claimed and the results of the combination are predictable, and (3) When combined, the elements perform the same function as they did separately.

For example, von Rosen teaches the missing element of *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* (see at least: Fig. 10B and 13B,

col. 5 lines 55-63) and further provides motivation for including such feature [note "automates the production of the merchandise..."(see at least: von Rosen, col. 2 lines 1-12, Fig. 13B).

Along the same lines, PTO 892 V teaches *offering a direct service to business customers for generating print products from their own content* and the fulfillment of *business customer* orders by the print merchant (see at least: Page 3 #1, Page 4 #s 3-5, Page 6 #s 6-8 and 11), and further where *image items being made available to said content retailer for public merchandising* are from *at least one third party content provider* (see at least: Page 3 #2, Page 6 #9, Page 9 #s12-14 (note: Marvel is a third party content provider)). In addition, PTO 892 V provides motivation to include the missing features [note: "...enable them to create printed products that deliver their message with impact..." (see at least: Page 3 #2; Also note Page 6 #8 and Page 4 #5)].

Aside from the cited motivation in each reference, because the elements are all known, the technical ability exists to combine the known features to yield predictable results, and the elements perform the same function when combined, it would have been obvious to one of ordinary still in the art to include such features in the system of Garfinkle since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Moreover, Applicant's assertions that the teachings of PTO 892 V are note applicable to Garfinkle and further where modification of Garfinkle in view of PTO 892 V would render

Garfinkle inoperable amount to nothing more than a mere conclusion unsupported by evidence or fact. Nowhere in Garfinkle or PRO 892 V does there exist a citable portion that criticizes, discredits, or otherwise discourages such modifications. In fact, as noted in the Final Office Action and above, modifying Garfinkle in view of PTO 892 V clearly produces distinct advantages. Furthermore, not only is are Garfinkle, von Rosen, and PTO 892 V in the same in the field of applicant's endeavor, each of Garfinkle, von Rosen, and PTO 892 V are reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). For example, each of Garfinkle, von Rosen, and PTO 892 V each pertain to the use of uploaded content in ordering print merchandise. The references thereby represent analogous art.

Regarding Applicant's remarks concerning claim 72, Von Rosen also teaches *itemization* of the presented bill including distinctly/separately showing the shipping (i.e. delivery) cost as well as the purchase price (see at least: Fig. 10A-11B). Though von Rosen only discloses a single print service provider, performing such tasks for a plurality of providers versus a single provider falls within the ordinary capabilities of one or ordinary skill in the art. Thereby, when taking into consideration the teachings of the art as a whole, it would have been obvious to one of ordinary skill in the art to incorporate such a feature.

Regarding claims 65-66, and 69-71, Applicants remarks depend on the remarks made with regards to claims 1, 63, 64, 67, 68, and 73. Thereby, Applicant's remarks are note persuasive for at least the reasons above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Jeffrey A. Smith/

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